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CLERK, U.S. DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

BY:

DEPUTY

7 UNITED STATES DISTRICT COURT
8 SOUTHERN DISTRICT OF CALIFORNIA



10 GEN-PROBE INCORPORATED,
11

12 Plaintiff,

13 v.

14 VYSIS, INC.,
15

16 Defendant.

No. 99CV2668H AJB

FIRST AMENDED COMPLAINT FOR
DECLARATORY RELIEF AND UNFAIR
COMPETITION

17 PLAINTIFF GEN-PROBE ALLEGES:

18 INTRODUCTION

19 1. This action concerns the nature and scope of any obligation of plaintiff Gen-Probe
20 Incorporated ("Gen-Probe") to make royalty payments to defendant Vysis, Inc. ("Vysis") pursuant
21 to a patent license agreement between the parties ("the License") in light of the invalidity and non-
22 infringement of United States Patent No. 5,750,338 ("the '338 patent") that is a subject of that
23 License. As set forth below, Gen-Probe asks this court to declare the '338 patent invalid and
24 further to declare that Gen-Probe's current and anticipated activities do not infringe any valid
25 claims of the '338 patent. As a corollary to those declarations, Gen-Probe also asks this Court to
26 declare its rights and obligations under the terms of the parties' License. Finally, Gen-Probe also
27 seeks relief from Vysis' continuing acts of wrongful and unfair conduct with respect to the '338
28 patent.

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THE PARTIES

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2 2. Gen-Probe was founded in San Diego in 1984 as a small "start up" company,
3 seeking to develop products based on the discoveries of a local research scientist. Over time, Gen-
4 Probe became one of the largest biotechnology firms in San Diego. Gen-Probe now maintains its
5 principal offices and research facilities at 10210 Genetic Center Drive in San Diego, where it
6 employs over 500 scientists and staff. Gen-Probe is organized under the laws of the State of
7 Delaware.

8 3. Gen-Probe is informed and believes that defendant Vysis, Inc. (hereinafter "Vysis"
9 or "the defendant") is a corporation organized and incorporated under the laws of the State of
10 Delaware. Gen-Probe is further informed and believes that Vysis maintains its principal place of
11 business in Downers Grove, Illinois and that it is controlled by BP Amoco, Inc.

JURISDICTION AND VENUE

12
13 4. Counts One and Two of this Complaint seek declaratory relief under the
14 Declaratory Judgment Act, Title 28, United States Code, Sections 2201 and 2202. This Court has
15 subject matter jurisdiction of the claims asserted thereunder by reason of Title 28, United States
16 Code, Sections 1331, 1338(a), 1338(b) and 1367.

17 5. Venue is proper in this District under Title 28, United States Code, Sections
18 1391(b) and 1400(b).

BACKGROUND

19
20 6. Living cells store genetic information in molecules of nucleic acid known as DNA.
21 These molecules consist of long, thin, chain-like strands which, in turn, are usually found in the
22 form of two tightly bound, complementary chains. DNA molecules retain their genetic information
23 in the form of a genetic code. The information in the DNA determines the life processes of each
24 organism. The information in the DNA is used to make related nucleic acid molecules called RNA
25 that cells use to manufacture proteins.

26 7. Through the work of its scientists and staff, Gen-Probe has developed and continues
27 to develop diagnostic tests that seek out the DNA or RNA of the infectious organisms. These types
28 of tests are generally referred to as "genetic probes" or "nucleic acid tests" ("NAT"). Gen-Probe

1 now markets DNA probe products that test for a wide range of microorganisms that cause
2 tuberculosis, strep throat, pneumonia, fungal infections and sexually transmitted diseases. Through
3 the efforts of its scientists and staff, Gen-Probe has emerged as the recognized world leader in the
4 development, manufacture and commercialization of diagnostic products based on its patented
5 genetic probe technology. Gen-Probe has received over 40 FDA clearances and approvals for
6 genetic probe tests to detect a wide range of microorganisms, including Chlamydia trachomatis,
7 Mycobacterium tuberculosis and Neisseria gonorrhoeae.

8 8. Many human diseases are caused by bacterial or viral agents that invade living
9 cells. Historically, the presence of these bacterial or viral agents was detected directly by time-
10 consuming methods such as culture or indirectly through the detection of antibodies.
11 Unfortunately, it takes time, sometimes weeks or months, to grow organisms in culture, and it
12 usually takes months for the body to manufacture antibodies in sufficient amounts to reveal the
13 presence of infectious agents. Consequently, these methods do not lend themselves to early
14 detection of infection. NAT addresses this problem.

15 9. Among the disease detection technologies recently applied by Gen-Probe is its
16 patented nucleic acid technology known as "Transcription-Mediated Amplification" ("TMA").
17 This technology enables Gen-Probe's NAT products to detect extraordinarily small quantities of the
18 nucleic acids of infectious agents.

19 10. In September 1996, Gen-Probe received a \$7.7 million grant from the National
20 Institutes of Health to develop TMA-based nucleic acid tests to be used in screening donated blood
21 for and human immunodeficiency virus (HIV), the causative agent of AIDS, and hepatitis C virus
22 (HCV), which causes a severe form of hepatitis.

23 11. At the time of the NIH grant to Gen-Probe, donated blood was principally tested by
24 procedures that detected the presence of antibodies to the viruses being screened. Due to the time it
25 takes for the body to make antibodies after initial infection, donated blood may test negative for
26 antibodies, yet still carry infectious viruses. This delay between the time of actual infection and the
27 time that antibodies can first be detected is often known as the "window period." Reduction of this
28 "window period" was a significant concern of the United States government and the primary focus

1 of the grant to Gen-Probe to develop NAT diagnostics for use in blood screening.

2 12. In fulfilling its obligations under the grant, Gen-Probe developed NAT tests to
3 detect the DNA of HIV and hepatitis C in blood. Through the use of its NAT test, Gen-Probe
4 believes that researchers and medical personnel may rapidly and *directly* detect the presence of
5 genetic material of viruses like HIV and HCV more accurately and without the complications and
6 delay associated with conventional *indirect* tests. As such, Gen-Probe believes that its new test
7 may significantly reduce the "window period" for detection of these extremely harmful viral agents
8 and resulting diseases.

9 13. Final development of the NAT tests for blood screening in the United States is now
10 taking place in testing conducted by the American Red Cross, America's Blood Centers, and others.
11 ("A Purity Quest; Local Biotech's Ultra-Sensitive Blood Screening Could Cut Risk of AIDS,
12 Hepatitis," *San Diego Union*, March 25, 1999, page C-1.) Use of the tests in the United States is
13 made pursuant to an Investigational New Drug Application filed with the United States Food and
14 Drug Administration. In blood tested by the American Red Cross, Gen-Probe's products have
15 detected hepatitis C and HIV which escaped detection by prior methods. ("New Blood Screening
16 Finds Virus Others Missed; Experimental Test Turns Up Hepatitis C In Donated Blood," *San Diego*
17 *Union*, April 2, 1999, page B-2.)

18 14. On September 21, 1999, the French Ministry of Health approved the sale of the
19 Gen-Probe blood screening tests in France. Gen-Probe anticipates approval of its tests for us in
20 Australia in early 2000.

21 15. Gen-Probe has entered into an agreement with Chiron Corporation ("Chiron") of
22 Emeryville, California, with respect to the development, manufacture, and distribution of blood
23 screening products. Gen-Probe is also a party to an agreement with Bayer Corporation ("Bayer") of
24 Emeryville, California with respect to the development, manufacture, and distribution of clinical
25 diagnostic products for the detection of HIV and hepatitis C, among other pathogens.

26 16. Gen-Probe anticipates that additional clinical trials in the United States of its
27 HIV/HCV tests for use in blood screening and in clinical diagnostics will commence in the first part
28 of 2000. Gen-Probe anticipates the conclusion of those clinical trials, and the initiation of

1 commercial sales in the United States of kits containing its HIV/HCV blood screening test, during
2 2000.

3 17. All of the Gen-Probe products are manufactured in San Diego, California.

4 THE '338 PATENT

5 18. Gen-Probe is informed and believes that on or about May 12, 1998, the United
6 States Patent and Trademark Office issued United States Patent No. 5,750,338 ("the '338 patent")
7 based upon Patent Application No. 238,080 filed on May 3, 1994.

8 19. Gen-Probe is informed and believes that defendant Vysis claims to be the owner, by
9 assignment, of the entire right, title and interest of the '338 patent. The claims of the '338 patent
10 purport to relate to assays and probes for polynucleotide molecules such as DNA and RNA.

11 20. In early 1999, Vysis informed Gen-Probe that it believed that the '338 patent
12 "applied" to Gen-Probe's NAT blood screening tests for HIV and HCV. Following further
13 discussions and to avoid any complications in Gen-Probe's plans for commercial deployment of its
14 NAT test kits, as of June 22, 1999 Gen-Probe obtained a license ("the License") from Vysis under
15 the '338 patent. Gen-Probe also obtained options to the License for its relationships with Chiron
16 and Bayer.

17 21. Under the terms of the License, Vysis requires Gen-Probe (and its allied parties if
18 the options are exercised) to make significant financial payments to Vysis as royalties on the sale of
19 any product covered by any valid claims of the '338 patent.

20 22. Notwithstanding the existence of the License, and as further alleged herein, Gen-
21 Probe believes that the claims of '338 patent are invalid in all material respects. Furthermore, Gen-
22 Probe believes that its NAT blood screening tests do not infringe any valid claim of the '338 patent.
23 As such, Gen-Probe disagrees with Vysis' contention that the claims of the '338 patent "apply" to
24 Gen-Probe's activities and contemplated products. For these same reasons, Gen-Probe contends
25 that it has no obligation to make any royalty payments to Vysis with respect to its present products
26 and activities and any contemplated products and activities that Vysis may later claim infringe the
27 claims of the '338 patent.

28 23. Gen-Probe has communicated to Vysis its belief that the claims of the '338 patent

1 are invalid. In support of that belief, Gen-Probe has provided Vysis with information that
2 demonstrates that the claims of the '338 patent are invalid. Gen-Probe has also advised Vysis of its
3 belief that its NAT test kits for use in detecting HCV and HIV in the Nation's blood supply do not
4 and will not infringe any valid claims of the '338 patent.

5 24. Notwithstanding its receipt of the foregoing information, Vysis persists in its
6 assertion that the claims of the '338 patent are valid and enforceable and that Gen-Probe is
7 obligated to make royalty payments in accordance with the terms of the License.

8 25. Based upon a long history of litigation between Gen-Probe and Vysis and its
9 affiliates, Gen-Probe reasonably anticipates that should it fail to pay royalties pursuant to the
10 License, Vysis will aggressively attempt to enforce its perceived rights under both the License and
11 the '338 patent by terminating the License and by initiating litigation against Gen-Probe, its allied
12 parties, and customers.

13 26. An actual case or controversy exists between Gen-Probe and Vysis concerning the
14 validity and infringement of the '338 patent and Gen-Probe's rights and obligations under the
15 License. The determination of the issues presented in this complaint will inure to the greater public
16 benefit and good.

17 COUNT ONE

18 NON-INFRINGEMENT OF THE '338 PATENT

19 27. Gen-Probe repeats, repleads and incorporates herein the allegations of paragraphs 1
20 through 26 of this complaint.

21 28. Gen-Probe's NAT test kits for use in detecting HCV and HIV in the Nation's blood
22 supply do not and will not infringe any valid claims of the '338 patent.

23 COUNT TWO

24 INVALIDITY OF THE '338 PATENT

25 29. Gen-Probe repeats, repleads and incorporates herein the allegations of paragraphs 1
26 through 26 of this complaint.

27 30. The claims of the '338 patent are invalid by reason of one or more provisions of
28 Title 35 of the United States Code.

COUNT THREE

DECLARATORY RELIEF

31. Gen-Probe repeats, repleads and incorporates herein the allegations of paragraphs 1 through 26 of this complaint.

32. An actual controversy has arisen and now exists concerning the rights and obligations of Gen-Probe pursuant to the terms of the parties' License. Those disputes arise from and their resolution depends upon the federal patent laws.

33. Gen-Probe seeks a declaration of its rights and obligations under the License, particularly in light of the invalidity and non-infringement of the '338 patent and defendant's acts of unfair competition as alleged herein.

COUNT FOUR

UNFAIR COMPETITION

34. Gen-Probe repeats, repleads and incorporates herein the allegations of paragraphs 1 through 33 of this complaint.

35. Vysis knows or should know the underlying facts establishing the invalidity of the claims of the '338 patent. In continuing to enforce the claims of the '338 patent, Vysis has acted and continues to act unfairly, inequitably and in bad faith. In addition, Vysis' actions constitute unlawful, unfair or fraudulent business practices under California Business & Professions Code Sections 17200, *et seq.*

36. By reason of the aforementioned acts of unfair competition and unlawful, unfair and fraudulent business practices, Gen-Probe is entitled to damages, as established at time of trial, restitution and injunctive relief.

WHEREFORE, Gen-Probe prays as follows:

1. For declarations:

- a. That Gen-Probe's products do not and will not infringe any valid claims of '338 patent;
- b. That the claims of the '338 patent are invalid; and
- c. Of Gen-Probe's rights and obligations under the parties' License;

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1 2. For a preliminary and permanent injunction enjoining and restraining defendant, its
2 respective officers, agents, servants, employees and attorneys, and all persons acting in concert
3 with them, and each of them:-----

4 a. From making any claims to any person or entity that Gen-Probe's products
5 infringe the '338 patent;

6 b. From interfering with, or threatening to interfere with the manufacture, sale,
7 license, or use of Gen-Probe's products by Gen-Probe, its allied parties, distributors, customers,
8 licensees, successors or assigns, and others; and

9 c. From instituting or prosecuting any lawsuit or proceeding, placing in issue
10 the right of Gen-Probe, its allied parties, distributors, customers, licensees, successors or assigns,
11 and others to make, use or sell Gen-Probe's products;

12 3. For recovery of Gen-Probe's damages, as proven at time of trial, and restitution of
13 any sums by which Vysis has been unjustly enriched;

14 4. For recovery of Gen-Probe's attorneys' fees and costs of suit incurred herein; and

15 5. For such other and further relief as the Court may deem just and proper.

16 Dated: January 25 1999

17 COOLEY GODWARD LLP
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20 By: 
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8 UNITED STATES DISTRICT COURT
9 SOUTHERN DISTRICT OF CALIFORNIA

10
11 GEN-PROBE INCORPORATED,
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13 v.

14 VYSIS, INC.,

15 Defendant.
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No. 99CV2668H AJB

PROOF OF SERVICE BY MAIL



PROOF OF SERVICE BY MAIL

I, Alison J. Lyman, hereby declare:

I am employed in the City of San Diego, County of San Diego, California in the office of a member of the bar of this court at whose direction the following service was made. I am over the age of eighteen years and not a party to the within action. My business address is Cooley Godward LLP, 4365 Executive Drive, Suite 1100, San Diego, California 92121-2128. I am personally and readily familiar with the business practice of Cooley Godward LLP for collection and processing of correspondence for mailing with the United States Postal Service, pursuant to which mail placed for collection at designated stations in the ordinary course of business is deposited the same day, proper postage prepaid, with the United States Postal Service.

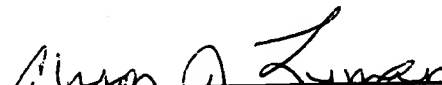
On January 26, 2000, I served: **FIRST AMENDED COMPLAINT FOR DECLARATORY AND INJUNCTIVE RELIEF** on the interested parties in this action by placing a true copy thereof, on the above date, enclosed in a sealed envelope, following the ordinary business practice of Cooley Godward LLP, for collection and mailing in the United States mail addressed as follows:

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I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct, and that this declaration was executed on January 26, 2000, at San Diego, California.


Alison J. Lyman

